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EXAMINER

HM12/05 LU

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1611

ART UNIT ID: 3 PAPER NUMBER: 8

DATE MAILED: 05/10/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 3. Aug 99 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 2 -- 30 and 32 -- 35 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 2 -- 30 and 32 -- 35 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

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Applicants response of March 8, 1998, is noted.

The claims in the application are claims 2-30 and 32-35.

Most of the present problems are on page 9 of the most recent response, and have to do with a multiple dependent claim.

Claims 2 and 3 are dependent on claims 32 and 33. The multiple depending has to be in an or relationship. A method of any one of claim 32 or claim 33 -- is suggested. In the lines of claims 33 and 34 they would have to read: amount of a compound of any one of claim 4, 6, 11, 16, 27, 28 or 29.

However, claim 33 would be a multiple dependent claim. This causes problems with claims 2 and 3 as a multiple dependent claim cannot be dependent on a multiple dependent claim.

Accordingly, claims 33, 34, 2 and 3 are rejected under 35 U.S.C. 112, 5th paragraph.

Claim 4 is rejected under 35 U.S.C. 103, as the proviso statements make it impossible to determine patentability. Certain compounds are removed. Each of the compounds removed have next adjacent compounds. Those next adjacent compounds are structurally obvious from the compound removed by proviso.

The next adjacent compound would be structurally obvious. See, *In re Dillon*, 919 F.2d at 696, 16 U.S.P.Q.2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q.2d at 1214 ("Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its

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homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a prima facie case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art di chloro compound on the basis of analogical reasoning. *Ex parte Wiseman* (POBA 1953) 98 U.S.P.Q. 277.

I do not have the time to determine each individual instance of next adjacent analogy, from the thousands of compounds claimed.

Claims 5-26 are rejected as being dependent on a rejected claim.

On page 278 of the specification *what* is cPr. I have heard of nPr and iso Pr. What is cPr. (Middle of page) three compounds.

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Each compound of claim 27 which runs from page 269 to page 303 is a separate question of patentability that I simply do not have time to undertake. Same claim 28.

Claim 27 is rejected under 35 U.S.C. 112, 2nd paragraph.

Claims 28 and 29 are rejected ~~as~~ a result of being dependent on a rejected claim.

Claim 30 is rejected under 35 U.S.C. 112, 5th paragraph. A multiple dependent claim must be in the "alternative", or relationship, the multiple depending need be expressed as: any one of claims 6, 11, 16, 27, 28 or 29.

There are two claims renumbered 33. One on page 5 and another on page 6 of the most recent amendment. Therefore, the previous rejection of claims 33 and 34 on page 9 of the most recent amendment are held to apply to claims 34 and 35 as those second set claims have been, and are hereby renumbered under 37 CFR 1.126, that requires consecutive numbering, to be claims 34 and 35.

Claims 32 and 33 (original numbering) are rejected as the prior art as a whole would have suggested a pharmaceutical for treating depression or anxiety. See page 2 of the specification.

Closely related compounds similar structure would expected to have similar utilities.

Any inquiry concerning this communication should be directed to J. M. Ford, at telephone number (703) 308-4721.

J. Ford:jmr

May 5, 1999

